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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,317	05/15/2001	Dhiren K. Marjadi	AEI-177-A	1121

7590 05/24/2005

Andrew R. Basile
Young & Basile, P.C.
3001 West Big Beaver Road, Suite 624
Troy, MI 48084

EXAMINER	
AUGUSTIN, EVENS J	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,317	MARJADI ET AL.	
	Examiner	Art Unit	
	Evens Augustin	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *04 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

This is in response to an amendment file on April 4th, 2005 for letter for patent filed on May 15th, 2001. In the amendment, claims 8 and 11 have been amended. Claims 1-12 are pending in the letter.

Response to Arguments

1. Applicant's arguments filed April 4th, 2005 have been fully considered but they are not persuasive.

Applicant argues that the prior arts fail to teach an inventive concept of a licensing method usable with applications running on both customer computer and application service provider. Examiner respectfully disagrees with applicant's characterization of the prior arts' inventive concept of a licensing method usable with applications running on both customer computer and application service provider. In particular, Christiano discloses a licensing method in which the program runs on the client's computer system (column 6, lines 32-59). Christiano also discloses a "floating" licensing method in which the software program can run anywhere on the network (column 1, lines 30-33, column 7, lines 1-4). Therefore, Christiano suggests that software can run anywhere on a network, including the licensing server. Conners et al. disclose a licensing system in which the application is running on the server hosting the application (column 2, lines 64-66, column 17, lines 19-37). Conners et al. disclose the reason for providing application hosting is to reduce the operating costs of installing software on PCs (column 6, lines 1-6). User customized applications also present a problem for IT professional during each service problem reported by the user. Before attempting to diagnose a reported problem, the

technician must ascertain the problem is not directly related to the user's preference selections. Therefore, to accurately troubleshoot a PC, the technician must be well versed with each application loaded on the user's PC (column 2, lines 47-53). According to Conners et al., hosting the application would alleviate that problem and therefore reduce maintenance costs.

With regard to the hindsight argument by the applicant, "any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Motivation to combine prior art references may exist in the nature of the problem to be solved (Ruiz at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (National Steel Car v. Canadian Pacific Railway Ltd., 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christiano (U.S 5,671,412), in view of Conner et al. (U.S 6,816,882).

As per claims 1-12, Christiano discloses a license management system for software applications. The system can do the following:

- Provide licensed units to users (column 3, line 46)
- Provide license to components of a package (column 4, lines 15-17)
- Assign a minimum amount of units that a particular digital content requires to be used (column 17, lines 36-38)
- Assign check out units based on the number of units being used by requester (column 19, line 67, column 20, lines 1-2)
- A license is granted when the requested units **plus** the checked out units are less than or equal to the total licensed units (column 29, lines 4-9, column 20 lines 1-3). A license is denied if the logic if false (figure 9, item 174).
- Each software program requires a minimum amount of units, in order for that particular program to be checked out (column 29, lines 20-24). The requested units for a particular program have to be greater than or equal to the minimum amount of units for that particular application (column 19, lines 40-45)
- When the requested amounts of units are being used, the available total licensed units are reduced by the requested units (column 29, lines 35-38). Therefore, the units are charged against the total available units during execution of the requested software.

However, Christiano did not explicitly describe a system that uses servers from an Application Service Provider (ASP) to host applications for the customer. Conner et al. discloses a system and method for automatically negotiating license agreements and installing arbitrary user-specified applications on Application Service Providers. The user can contract with an ASP

the hosting of applications and interact with those applications via a thin client (column 2, lines 64-66) for on-demand delivery of application component (column 7, line 1). Therefore, it would have been obvious for one skilled in the art of digital content distribution and delivery over an open network to provide the user with an option to execute requested digital content on an ASP's server and to provide pay per use licensing agreement, based on applications share among multiple enterprises with multiple users on a virtual host (column 10, lines 8-10). It would have been obvious to do because the ASP would enable the user to minimize the costs of applications by reducing the skill requirements for operation and maintenance of the business application (column 9, lines 34-37).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
May 20, 2005
Art Unit 3621

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600